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DELIVERY MODE

PAPER

FIRST NAMED INVENTOR ATTORNEY DOCKET NO. CONFIRMATION NO. APPLICATION NO. FILING DATE 10/575,350 06/02/2006 Toshio Yoshizawa 2006_0496A 9084 7590 08/09/2007 **EXAMINER** WENDEROTH, LIND & PONACK, L.L.P. MURRAY, JEFFREY H 2033 K STREET N. W. SUITE 800 PAPER NUMBER ART UNIT WASHINGTON, DC 20006-1021 1624

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

•		Application No.	Applicant(s)	Applicant(s)	
Office Action Summary		10/575,350	YOSHIZAWA ET A	YOSHIZAWA ET AL.	
		Examiner	Art Unit		
		Jeffrey H. Murray	1624	· 	
Period fo	The MAILING DATE of this communication or Reply	appears on the cover sheet wi	th the correspondence add	dress	
WHIC - Exte after - If NC - Failu Any	ORTENED STATUTORY PERIOD FOR RECHEVER IS LONGER, FROM THE MAILING insigns of time may be available under the provisions of 37 CFR SIX (6) MONTHS from the mailing date of this communication. Operiod for reply is specified above, the maximum statutory per re to reply within the set or extended period for reply will, by state to reply within the set or extended period for reply will, by state ply received by the Office later than three months after the med patent term adjustment. See 37 CFR 1.704(b).	DATE OF THIS COMMUNIC R 1.136(a). In no event, however, may a r riod will apply and will expire SIX (6) MON atute, cause the application to become AB	CATION. eply be timely filed THS from the mailing date of this co ANDONED (35 U.S.C. § 133).		
Status					
1)[🛛	Responsive to communication(s) filed on 10	0 April 2006.	•		
2a)□	•	This action is non-final.			
3)	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is				
	closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.				
Disposit	ion of Claims	1			
4) 🖂	Claim(s) <u>1-23</u> is/are pending in the application.				
	4a) Of the above claim(s) is/are withdrawn from consideration.				
5)	Claim(s) is/are allowed.				
6)	Claim(s) is/are rejected.				
7)	Claim(s) is/are objected to.				
8)⊠	Claim(s) 1-23 are subject to restriction and/	or election requirement.			
Applicati	on Papers			·	
9) The specification is objected to by the Examiner.					
10)☐ The drawing(s) filed on is/are: a)☐ accepted or b)☐ objected to by the Examiner.					
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).					
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).					
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.					
Priority (ınder 35 U.S.C. § 119				
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:					
	1. Certified copies of the priority docum	ents have been received.			
	2. Certified copies of the priority docum				
	3. Copies of the certified copies of the p		received in this National	Stage	
	application from the International Bur		and the sale		
* See the attached detailed Office action for a list of the certified copies not received.					
Attachme-	tic)	•			
Attachment(s) 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413)					
2) Notic	e of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s	s)/Mail Date nformal Patent Application		
	mation Disclosure Statement(s) (PTO/SB/08) r No(s)/Mail Date	5)			
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DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- I. The compound or composition of the formula I, according to Claims 1-19 and 23.
- II. The method for inhibiting c-Jun N-terminal kinase, according to Claim 20.
- III. The method for preventing and/or treating c-Jun N-terminal kinase-mediated diseases, according to Claim 21.
- IV. A use of the compound, according to Claim 22.
- 2. The inventions listed as Groups I IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature linking the claims is a compound of general formula I. Prior art exists which causes the core structure in the current application to lack a special technical feature. The core structure here is a heterocyclic ring which may be substituted by certain R¹ groups. This ring is seen in numerous patents and papers. For example, Bruni et. al., Farmaco,

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(1993), 48(2) 309-19 teaches an unsubstituted pyrazalopyrimidine ring. Therefore the feature linking the claims does not constitute a special technical feature as defined by PCT Rule 13.2 as it does not define a contribution over the art.

Accordingly, Groups I – IV are not so linked by the same or a corresponding special technical feature as to form a single general inventive concept.

The examiner has required restriction between product and process claims. Where 3. applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double

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patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

4. This application contains claims directed to the following patentably distinct species: All the various named compounds and compositions that exist in Claims 7 and 13. The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claim 1 and 8 are generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete <u>must</u> include

(i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

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The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey H. Murray whose telephone number is (571) 272-9023. The examiner can normally be reached on Mon.-Thurs. 7:30-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisors, Mr. James Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a US PTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JHM

James O. Wilson Suncaison Patent Examiner

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